

Appl. No.: 09/902,475 (Re-issue)
Reply, dated November 29, 2007
Reply to Office Action of June 1, 2007

REMARKS/ARGUMENTS

This is a full and timely response to the Office Action dated June 1, 2007. Accompanying this amendment is a petition and fee for a three month extension of time extending the response deadline to December 1, 2007. Applicant notes with appreciation the Examiner's thorough examination of the application as evidenced by the Office Action.

Prior to the issuance of the present Office Action, Claims 1-21 and 32-44 were canceled without prejudice thereby leaving Claims 22-31 and 45-51 pending in the present reissue application. It is respectfully submitted that pending Claims 22-31 and 45-51 are patentable. As such, Applicant respectfully requests reconsideration and allowance of the present claims.

Supplemental Declaration

On page 2 of the present Office Action, the Examiner has rejected pending Claims 22-31 and 45-51 on the grounds that the claims are based upon a defective reissue declaration under 35 U.S.C. §251. A supplemental declaration signed by all of the named inventors is filed concurrently herewith. Accordingly, the Applicant respectfully requests the Examiner to withdraw this rejection.

Recapture Rejection

The present application is a continuation of an application for reissue of U.S. Patent No. 5,968,560 ("the '560 patent"). The parent reissue application, Application No. 09/553,413, has issued as RE39,769. During prosecution of the parent reissue application, a recapture rejection was asserted. On appeal to the Board of Patent Appeals and Interferences, Appeal No. 2006-0123, the recapture rejection was reversed in a Decision on Appeal mailed February 24, 2006. Applicant respectfully asserts that the Board's reasoning for reversing the recapture rejection in the parent reissue application is applicable to the recapture rejection of the present claims and as a result, the recapture rejection should be withdrawn.

As background, the sole independent claim in the original application (i.e. Claim 1) initially recited a device for manufacturing containers that included a combination of shells, shell holders and mold carriers. During prosecution of the original application, Claim 1 was amended

to further define the mold carriers as being “made in the form of enveloping structures.” In the parent reissue application, the Applicant presented several claims that did not explicitly recite a mold carrier and these claims were rejected by the Examiner on a theory of recapture. On appeal, the Board concluded that the rejection was incorrect because the implicit limitation to the shell holders (i.e. that they be supported by the enveloping mold carriers) was carried forward to the mold assembly subcombination that was recited in the reissue application. It is important to note that the Board also stated that “[t]he reissue claims cannot include the mold carriers because the mold carriers are not part of the claimed mold assembly subcombination.” (Appeal Decision p. 5).

On appeal, the Board also rejected the Examiner’s recapture argument that the limitation of “the shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures” did not limit the shape of the shell holders. The Board reasoned that this claim language “limits the shell holders structurally to shapes that they are capable of being supported by two mold carriers made in the form of enveloping structures.” (Appeal Decision, FN1, p. 4).

In the present Office Action, the Examiner has maintained his rejection of Claims 48-50¹ based on a theory of recapture despite language in the claims requiring that the mold shells are configured to be supported by enveloping mold carriers via interposed mold shell holders. The Examiner notes that these claims explicitly recite neither mold carriers nor mold shell holders and concludes that the Board’s initial decision does not extend to claims 48-50 because, while the Board found that the mold shell holders were implicitly limited by the express amendment of the mold carriers, there was no implicit amendment of the mold shells.

Contrary to the Examiner’s arguments, the Boards logic from the original appeal can and indeed should be extended to Claims 48-51. First, Claims 48-51 are directed to a mold shell assembly, which is a subcombination as opposed to the combination claim in the original patent Claim 1. Applying the Board’s logic with respect subcombinations, Claims 48-51 cannot include the mold carriers or the shell holders because they are not part of the claimed mold shell

¹ Applicant notes that the Examiner has rejected on the cover page, but not noted which ground for rejection applies to Claim 51 in the present office action. This claim was added with the RCE filed April 24, 2007.

assembly subcombination.

Additionally, the Board assessed during the first appeal whether the mold shell holders had been limited by the amendment made in the original patent to the mold carriers. In particular, the Board reasoned that shell holders were structurally limited by requiring them to be capable of being supported by mold carriers in the form of enveloping structures. Claims 48-51 of the present application include the same types of limitations. For example, Claim 48 requires:

 said mold shells being configured to be supported by mold carriers made in the form of enveloping structures via interposed mold shell holders, said mold shell holders being shaped to be supported by said mold carriers made in the form of enveloping structures

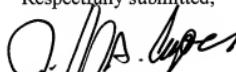
Applying the logic from the Board's decision to the amendment in the original application, contrary to the Examiner's arguments, the mold shells of the original claims were structurally limited by requiring them to be "capable of being supported by two mold carriers made in the form of enveloping structures." (Appeal Decision, FN1, p.4). In other words, the amendment in the original application implicitly limited the shape of the mold shells to shapes that can be supported by such enveloping mold carriers. *Id.* Since reissue Claims 48-51 retain the requirement that the holders be shaped to be received by enveloping mold carriers, there is no recapture.

Finally, the Examiner has argued that "[i]t appears unlikely that [the] applicant intended to further define the shape of the shell in the amendment of the Patent-560 by amending the mold carriers which are made in the form of enveloping structures." To the contrary, clearly the amendment resulted in a claimed structure restricting the mold shells to those capable of being used with enveloping mold carriers. If the Examiner believes that the mold shells were not limited in the original application, then the Examiner should conclude that the Applicant did not surrender any subject matter with respect to the mold shell itself and withdraw the recapture rejection of mold shell claims.

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It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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CERTIFICATION OF ELECTRONIC FILING

I hereby certify that this paper is being filed via the Electronic Filing System (EFS) to the United States Patent and Trademark Office on the date shown below.


Shana Moore

11.29.07
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